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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,889	04/14/2004	Toby Wexler	20040414	7321
31346	7590	09/01/2005	EXAMINER	
ROBERT N. MONTGOMERY 109 BROWNLEE AVE. BROUSSARD, LA 70518-3021			SMITH, KIMBERLY S	
			ART UNIT	PAPER NUMBER
			3644	

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/824,889

Applicant(s)

WEXLER, TOBY

Examiner

Kimberly S. Smith

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 8-10, 12, 13, 18-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11 and 14-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04/14/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in the reply filed on 08/15/05 is acknowledged. The traversal is on the ground(s) that filing the nails is not a means for practicing the invention in a materially different process. This is not found persuasive because the filing of a nail and the clipping of the nail not only require a different process but a different mechanism for carrying out the process. While the Examiner agrees that filing and clipping are obvious equivalents, they are no less materially different processes. The requirement is still deemed proper and is therefore made FINAL.

2. Claims 8-10, 12, 13 and 18-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 08/15/05. While the Applicant has elected the liquid adhesive as the means for adhesion, both the aerosol and adhesive powder are examined on the merits as they are considered to be obvious variants of the liquid adhesive and thereby not patentably distinct.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "22" and "20" have both been used to designate tip of the nail. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be

Art Unit: 3644

labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because Figure 25, replace "72" with - -76- -. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities: page 9, line 7: replace "10" following "cap" with - -8- -, page 10, line 8: replace "20" with - -18- -, page 10, line 9: replace "22" with - -20- -. Appropriate correction is required.

Claim Objections

6. Claims 1-7, 11 and 14-17 objected to because of the following informalities: the claims interchange the “polymeric sheath” as both the combination of the sheath and the second polymer layer and the polymeric sheath as a singular entity. It is suggested the Applicant use a preamble such as “An animal toe nail covering comprising...” To differentiate the combination as the “toe nail covering” and the internal structure as the “polymeric sheath”. Appropriate correction is required.

7. Claim 2 is objected to because of the following informalities: the applicant has stated the second layer of polymer has a durometer greater than that of the polymeric sheath. The term “durometer” is used in inappropriate context, as it is an instrument for measuring hardness. As such, the claim has been interpreted to mean, “the second layer of polymer has a hardness greater than that of the polymeric sheath.” Appropriate correction is required.

8. Claim 7 is objected to because of the following informalities: line 2, replace “sheaths” with - sheath- -. Appropriate correction is required.

9. Claims 7, 14 and 15 are objected to because of the following informalities: these claims include a limitation to “adhesive means” which are not supported by a proper antecedent basis. Replacing “means” with - element- - would obviate this objection. Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: a releasing agent. The specification states that the delamination property is a result of the releasing agent. The polymeric sheath does not comprise a delamination but provides for delamination via the releasing agent.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Field, US Patent 4,908,881.

Field discloses a polymeric sheath (44) having an opening (46) and an internal and external shape generally consistent with that of an animal's toenail, the polymeric sheath comprising a second layer of polymer (48) covering at least a portion of the polymeric sheath (reference Figure 3).

Regarding Claim 2, Field discloses the second layer of polymer is harder than that of the polymeric sheath (column 3, line 17 and column 3, lines 27-30).

Art Unit: 3644

Regarding claim 5, Field discloses that the second layer may be removable from the sheath thereby providing the sheath with the delamination between the sheath and the second layer of polymer.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 3, 6, 7 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Field, US Patent 4,908,881.

Field discloses the invention as claimed. However, Field does not positively disclose that the second layer of polymer is a different color than the polymeric sheath. Field does disclose that the second layer may be prepared in various colors and designs for aesthetic purposes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a sheath of differing color than the second polymer layer so as to provide more contrast and thereby add to the aesthetic nature of the device.

Regarding claim 6, Field discloses that the second polymer layer is mounted to the sheath. While not positively stating that an adhesive element is used, it is obvious that such an adhesive element must be present as there is no structural mechanism in which to retain the second polymer layer onto the sheath.

Regarding claims 7, 14 and 15, while Field suggests the use of an adhesive, the type of adhesive to be used is not disclosed. However, it is evident from the structure that the adhesive to provide the mounting of (48) at (50) must be located between the polymeric sheath and the second layer of polymer. One of skill in the art would consider the use of a liquid adhesive, a powered adhesive or an aerosol adhesive as a matter of obvious routine choice of design rather than constitute a patentably distinct inventive step barring a convincing showing of evidence to the contrary.

Regarding claims 16 and 17, the process of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. These are product-by-process claims.

17. Claims 4 and 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Field as applied to claim 1 above, and further in view of Johns, US Patent 2,285,981.

Field discloses the invention substantially as claimed. However, Field does not disclose the use of internal cleats. Johns teaches within the same field of endeavor the use of internal cleats (7) for preventing the sheath from slipping off. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the cleats as taught by Johns with the device of Field in order to maintain the sheath in the correct position.

Regarding claim 11, Fields as modified per the discussion above provides for a textured inner wall surface.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Irizzary (US 6,367,425), Larson (US 2,028,674).

Art Unit: 3644

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly S. Smith whose telephone number is 571-272-6909.


The examiner can normally be reached on Monday thru Friday 10:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimberly S Smith
Examiner
Art Unit 3644

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